

48



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,301	05/25/2001	Eiichi Nakano	F-11150	2797
7590 03/31/2005 McGinn & Gibb, PLLC Suite 200 8321 Old Courthouse Road Vienna, VA 22182-3817			EXAMINER COFFY, EMMANUEL	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/864,301

Applicant(s)

NAKANO ET AL.

Examiner

Emmanuel Coffy

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

***Response to Amendment***

1. This action is responsive to the application filed on November 29, 2004. Claims 1-12 were amended. Claims 13-18 were added. Claims 1-18 are pending. Claims 1-18 are directed to a System and Method for a "Calculation Service Providing System."

***Response to Arguments***

2. Applicant's arguments have been fully considered but they are not persuasive. In response to Applicant's arguments, 37 CFR § 1.111(c) requires applicant to show how the amendments avoid such references or objections."

The dependent claims stand rejected as articulated in the First Office Action and all objections not addressed in Applicant's response are herein reiterated.

In the remarks applicant alleges that the claim amendments are made only to assure grammatical and idiomatic English and improved form under United States practice, and are not made to distinguish the invention over the prior art or narrow the claims or for any statutory requirements of pate. However, claims 13-18 were added prompting new search.

The Examiner maintains the arguments presented in the First Office Action as outlined below and the rejection is therefore sustained.

3. Bodily Incorporation

In response to applicant's argument that neither Lavey, Jr. nor does Dias disclose calculation servers, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references

would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, Ballard teaches an advertising Service Provider which calculates the distance function for each advertisement. (See col. 11, lines 10-29.) Applicant's invention is directed to "calculation service" an amorphous and nebulous recitation whereas Ballard teaches a "distance calculation service" a specific limitation. Applicant is invited to demonstrate how calculation service patentably differs from distance calculation and amount charged calculation.

The Examiner notes that Yoon (US 6,173,407) teaches a client using a web infoshop service system where the web infoshop service system, in place of a charged content provider, authenticates a client and performs calculation of an amount of charge. (See col. 2, lines 3-7.)

#### 4. Piecemeal Analysis

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant acknowledges that Ballard's system includes (1) a network, (2) a host system or Web server, and (3) a plurality of end user computers or terminals. As discussed above, Ballard teaches a distance calculation service.

Lavey, Jr. et al. discloses a web browser, web server, internet service provider and client application. (See Fig. 2A.)

Dias et al. is directed to load balancing comprising a plurality of clients and a plurality of servers.

The test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### **Claim Objections**

5. Claim 15 is objected to because of the following minor informalities. Claim 15 is a dependent claim, which claim dependency on 3. A claim that depends from a dependent claim should not be separated by any claim that does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general applicant's sequence will not be changed. See MPEP §608.01(n). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

#### ***Claims 1-18 are rejected.***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 7 are rejected under 35 U.S.C. §112 ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention due to ambiguous language from direct translation. A reasonable artisan skilled in the art could not comprehend the claims as written. The claims recite: "calculation service." This recitation is undefined within the claim language or in the specification. It is not clear what the boundary of the claim is. Hence, the scope of the claim is unascertainable.

However, in order to expedite a more complete examination the Examiner asserts that this invention is understood as: "any calculation performed", the broadest interpretation in light of the specification.

8. Claims 2-6 and 8-18:

Above claims are rejected by virtue of their dependency upon claims 1 and 7.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-3, 5-9 and 11-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ballard (US 6,182,050) in view of Lavey, Jr. et al. (US 6,023,698.)

Ballard teaches the invention substantially as claimed including advertisements distributed on-line using target criteria screening with method for maintaining end user privacy. The advertising service provider sends executable filter programs which run on the end user computer to test whether a corresponding advertisement is to be downloaded and displayed. (See abstract).

Claim 1:

Referring to claim 1, Ballard teaches calculation service providing system, comprising calculation servers, a Web server and terminals which are connected to one another on a network, (See col. 5, lines 14-64)

wherein each of said calculation servers stores one or more applications for providing calculation service, (See col. 11, lines 10-29).

wherein said Web server stores and publishes on said network one or more procedure data files, in each of which procedure data defining a calculation service using said one or more applications stored in one or more of said calculation servers is described, and (See col. 6, lines 40-63).

wherein each of said terminals executes a procedure processing program for having one or more of said calculation servers execute one or more applications on the basis of said procedure data described in said procedure data file downloaded from said Web server.

Ballard teaches a wide area network which stores information accessible to the network server computers, remote networks and client computers. (See col. 5, lines 9-14). Ballard further teaches calculation servers associated with producing demographic data. (See col. 11, lines 13-15). Ballard does not specifically teach terminals executing a procedure processing program although Ballard does teach an executable computer program code. (See col. 8, lines 22-24). However, Lavey Jr. teaches a client computer executing a procedure processing program interacting with an online resource server. (See col. 5, lines 53 –col. 6, line 4). Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Ballard with the server system taught by Lavey, Jr. Such a system would allow a user to easily create an Internet application allowing the user to use their preferred Internet service provider with a standard application programmer's interface (API). Therefore, claim 1 is rejected.

Claim 2:

Referring to claim 2, Ballard teaches the calculation service providing system as set forth in claim 1, wherein each of said terminals accesses one or more said calculation servers with telnet protocol and ftp protocol when having the calculation servers execute one or more applications and transfer one or more files, respectively. (See col. 11, lines 12-15 and col. 5, lines 9-13).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the teachings of Ballard. Therefore, claim 2 is rejected.

Claim 3:

Referring to claim 2, Ballard substantially teaches the calculation service providing system as set forth in claim 1, wherein each of said terminals executes a procedure data creation program for creating each of said procedure data files.

Ballard teaches calculation servers associated with producing demographic data in order to select the advertisement having the smallest distance. Ballard does not specifically teach terminals executing a procedure processing program although Ballard does teach an executable computer program code. (See col. 8, lines 22-24). However, Lavey Jr. teaches a client computer executing a procedure processing program interacting with an online resource server. (See col. 5, lines 53 – col. 6, line 4). Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Ballard with the server system taught by Lavey, Jr. Such a system would allow a user to easily create an Internet application allowing the user to use their preferred Internet service provider with a standard application programmer's interface (API). Therefore, claim 3 is rejected.



Claim 5:

Referring to claim 5, it recites the calculation service providing system as set forth in claim 1, wherein a Web browser is installed on each of said terminals, and wherein said procedure processing program is downloaded from said Web server to each of said terminal and executed on said Web browser.

Ballard teaches calculation servers associated with producing demographic data in order to select the advertisement having the smallest distance. Ballard does not specifically teach terminals executing a procedure processing program although Ballard does teach an executable computer program code. (See col. 8, lines 22-24). However, Lavey Jr. teaches procedure processing program which is downloaded from said Web server to each of said terminal and executed on said Web browser. (See col. 5, lines 6-10; col. 5, lines 53-col. 6, line 4 and col. 6, line 60 – col. 7, line 22).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Ballard with the server system taught by Lavey, Jr. Such a system would provide an interface that allows programmers to easily create applications that allow the user to use their preferred Internet service provider for obtaining a convenient seamless connection to the Internet for communication with an on-line site. Therefore, claim 5 is rejected.

Claim 6:

Referring to claim 6, it recites the calculation service providing system as set forth in claim 3, wherein a Web browser is installed on each of said terminal, and wherein said procedure data creation program is downloaded from said Web server to each of said terminal and executed on said Web browser.

Ballard teaches calculation servers associated with producing demographic data in order to select the advertisement having the smallest distance. Ballard does not specifically teach terminals executing a procedure data creation program although Ballard does teach an executable computer program code. (See col. 8, lines 22-24). However, Lavey Jr. teaches procedure data creation program which is downloaded from said Web server to each of said terminal and executed on said Web browser. (See col. 2, lines 52-64; col. 5, lines 6-10; col. 5, lines 53-col. 6, line 4 and col. 6, line 60 – col. 7, line 22).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Ballard with the procedure data creation program downloaded from a server system taught by Lavey, Jr. Such a system would provide an interface that allows programmers to easily create applications that allow the user to use their preferred Internet service provider for obtaining a convenient seamless connection to the Internet for communication with an on-line site. Therefore, claim 6 is rejected.

11. Claim 4 is rejected in further view of Dias et al. (US 6,119,143).

Claim 4:

Referring to claim 4, it recites the calculation service providing system as set forth in claim 1, wherein said Web server stores a procedure data optimization program for dynamically rewriting each of said procedure data files on the basis of loads on respective calculation servers so that the rewritten procedure data file is described with an optimum calculation server for executing each application among calculation servers executable the application.

Ballard teaches calculation servers associated with producing demographic data in order to select the advertisement having the smallest distance. Ballard does not specifically teach terminals executing procedure data file. However, Lavey Jr. teaches procedure data creation file. (See col. 2, lines 52-64; col. 5, lines 6-10; col. 5, lines 53-col. 6, line 4 and col. 6, line 60 – col. 7, line 22).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Ballard with the procedure data creation file taught by Lavey, Jr. Such a system would provide an interface that allows programmers to easily create applications that allow the user to use their preferred Internet service provider for obtaining a convenient seamless connection to the Internet for communication with an on-line site.

Neither Ballard nor Lavey teach performing a task on the basis of loads. However, Dias teaches a method for load balancing. The method partitions clients into groups based on their request load. Each group is dynamically scheduled among nodes, thus avoiding high load groups from being allocated to the same node and overloading the system.

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Ballard and the procedure data creation file taught by Lavey, Jr. with the load balancing taught by Dias. This system is preferred for it would enhance quality of service. Therefore, claim 4 is rejected.

Claims 7-12

As for claims 7-12, they do not teach or define any significantly new limitation above and beyond claims 1-6 to warrant particular treatment, and therefore are rejected for similar reasons.

Claim 13 (New)

The calculation service providing system as set forth in claim 1, wherein said Web server stores and makes available for downloading the procedure processing program.

Ballard teaches distance calculation service associated with producing demographic data in order to select the advertisement having the smallest distance. Ballard does not specifically teach downloading files. However, Lavey Jr. teaches downloading files. (See col. 1, lines 33-36; line 10-12).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Ballard with file downloading taught by Lavey, Jr. Such a system would provide an interface that allows clients to augment and update data used by an application by providing convenient and transparent access to data.

Claim 14 (New)

The calculation service providing system as set forth in claim 1, wherein said Web server stores and makes available for downloading a procedure data display program to cause display of icons corresponding to procedures for accessing said calculation servers and executing the applications.

Ballard teaches distance calculation service associated with producing demographic data in order to select the advertisement having the smallest distance. Ballard does not specifically teach downloading files. However, Lavey Jr. teaches downloading files and displaying the status of the object requested in the form of an icon. (See col. 1, lines 33-36; col. 2, lines 60-65; col. 6, lines 19-23).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Ballard with file downloading taught by Lavey, Jr. Such a system would provide a visual interface that allows clients to easily visualize the process of augmenting and updating data used by an application by providing convenient and transparent access to data.

Claim 15 (New)

The calculation service providing system as set forth in claim 3, wherein said Web server stores and makes available for downloading the procedure data creation program.

Ballard teaches distance calculation service associated with producing demographic data in order to select the advertisement having the smallest distance. Ballard does not specifically teach downloading files. However, Lavey Jr. teaches downloading files from a website. (See col. 4, lines 1-10).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Ballard with file downloading taught by Lavey, Jr. Such a system would provide an interface that allows clients to augment and update data used by an application by providing convenient and transparent access to data.

Claim 16 (New)

The calculation service providing method as set forth in claim 7, further comprising downloading the procedure processing program from said Web server.

Ballard teaches distance calculation service associated with producing demographic data in order to select the advertisement having the smallest distance. Ballard does not specifically teach downloading files. However, Lavey Jr. teaches downloading files from a website. (See col. 4, lines 1-10).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Ballard with file downloading taught by Lavey, Jr. Such a system would provide an interface that allows clients to augment and update data used by an application by providing convenient and transparent access to data.

Claim 17 (New)

The calculation service providing method as set forth in claim 7, further comprising downloading from said Web server a procedure data display program to cause display of icons corresponding to procedures for accessing said calculation servers and executing the applications.

Ballard teaches distance calculation service associated with producing demographic data in order to select the advertisement having the smallest distance. Ballard does not specifically teach downloading files. However, Lavey Jr. teaches downloading files from a website. (See col. 4, lines 1-10).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Ballard with file downloading taught

by Lavey, Jr. Such a system would provide an interface that allows clients to augment and update data used by an application by providing convenient and transparent access to data.

Claim 18 (New)

The calculation service providing method as set forth in claim 9, further comprising downloading the procedure data creation program from said Web server.

Ballard teaches distance calculation service associated with producing demographic data in order to select the advertisement having the smallest distance. Ballard does not specifically teach downloading files. However, Lavey Jr. teaches downloading files from a website. (See col. 4, lines 1-10).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the teachings of Ballard with file downloading taught by Lavey, Jr. Such a system would provide an interface that allows clients to augment and update data used by an application by providing convenient and transparent access to data.

**12. THIS ACTION IS MADE FINAL.**

Applicant's addition of new claims (amendment) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

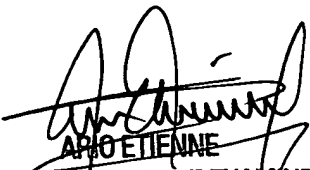
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Coffy whose telephone number is (571) 272-3997. The examiner can normally be reached on 8:30 - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Emmanuel Coffy  
Patent Examiner  
Art Unit 2157

\*\*\*EC  
March 1, 2005

  
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